

REMARKS

Claims 1-2, 8, 9 and 15-26 were examined and reported in the Office Action. Claims 1-2, 8, 9 and 15-26 are rejected. Claims 2, 9, 16 and 18 are canceled. Claims 1, 8, 15 and 17 are amended. Claims 1, 8, 15, 17 and 19-26 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 102(e)

It is asserted in the Office Action that claim 17 is rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent Application Publication No. 2003/0054863 by Lee et al. ("Lee"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (*In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Lee discloses displaying, for an incoming call, a caller number to identify the caller. Applicant's claimed invention also implements a caller information identification service. Applicant's claimed invention, however, not only renovates the caller information appropriately by the call, but also reduces a burden of the system where the initiation time of the call is not delayed.

Distinguishable, Lee does not teach, disclose or suggest Applicant's claim 17 limitations of a radio frequency transmitter for transmitting data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up, wherein

the data includes the caller information and a telephone number of a receiving party.

Therefore, since Lee does not teach, disclose or suggest all of Applicant's amended claim 17 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(e) has not been adequately set forth relative to Lee. Thus, Applicant's amended claim 17 is not anticipated by Lee.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejection for claim 17 is respectfully requested.

II. 35 U.S.C. § 103

A. It is asserted in the Office Action that claims 15-18 and 23-26 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 6,675,008 issued to Paik et al. ("Paik") in view of Lee. Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), *emphasis added*.)

Lee discloses displaying caller information using image data. Paik discloses simultaneously sending caller information when a telephone call is made to a mobile terminal.

According to Applicant's claimed invention, the newest caller information can be renewed at the receiver side by the caller. Further, in Applicant's claimed invention the caller information transmission is implemented simultaneously during the previous call by additionally sending the caller information from the caller's terminal to the receiver's terminal while the previous call is being made. Additionally, Applicant's claimed invention transmits the caller information to at least one designated receiver terminal, which is in a state that can receive the caller information and where it waits until the rest of the terminals enters a state to receive the caller information. Therefore, the resources of the network are freed and the transmission that is classified by groups/individuals is possible.

Even if Lee is combined with Paik, however, the resulting invention would still not teach, disclose or suggest Applicant's amended claim 15 limitations of

a radio frequency (RF) receiver for receiving data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up; a memory unit for storing the caller information to be linked with a telephone number of a caller terminal; and a controller for controlling a mobile terminal to display the caller information when a paging signal is received for a call with the caller terminal after terminating the voice call, wherein the caller information is automatically stored in the receiver terminal by linking a telephone number contained in the data with a telephone number stored in a telephone directory,

nor Applicant's amended claim 17 limitations of

a memory unit for storing caller information; and a radio frequency transmitter for transmitting data including caller information during a voice call over a different channel from a channel for the voice call after a call connection is set up, wherein the data includes the caller information and a telephone number of a receiving party.

Since neither Lee, Paik, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 15 and 17, as listed above, Applicant's amended claims 15 and 17 are not obvious over Lee in view of Paik since a *prima facie* case of

obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 15 and 17, namely claims 23 and 24, and 25 and 26, respectively, would also not be obvious over Lee in view of Paik for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 15-18 and 23-26 are respectfully requested.

B. It is asserted in the Office Action that claims 1-2, 8-9, 19-20 and 21-22 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U.S. Statutory Invention Registration H1714 issued to Partridge, III (“Partridge”) in view of U.S. Patent Application No. 5,907,604 issued to Hsu (“Hsu”), and further in view of Lee. Applicant respectfully traverses the aforementioned rejection for claims 1-2 and 8-9 for the following reasons.

Lee discloses displaying caller information using image data.

Partridge discloses automatic still image selection and transmission upon the placement of a call to a video telephone or terminal. Neither Lee nor Partridge disclose, teach or suggest a method or a system by which caller information is transmitted or received during a voice call over a different channel from a channel for the voice call after a call connection is set up nor that the caller information is automatically stored in the receiver terminal by linking a telephone number contained in the data with a telephone number stored in a telephone directory.

Hsu discloses that the caller's Caller ID is transmitted prior to, or concurrently with, a telephone call intended to be answered by the receiving party (see Hsu, Abstract). Accordingly, it is clear that in Hsu the image is transmitted before establishing a communication between the caller terminal and the receiver terminal. Hsu does not teach, disclose or suggest “a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up,” “at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up,” nor “the caller information is

automatically stored in the receiver terminal by linking a telephone number contained in the data with a telephone number stored in a telephone directory.”

Therefore, even if Lee and Partridge are combined with Hsu, the resulting invention would still not teach, disclose or suggest the limitations of Applicant’s amended claim 1 of

a caller terminal for storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up; the service system for receiving the data including the caller information from the caller terminal and transmitting the data to a receiver terminal; and the receiver terminal for receiving the data from the service system, storing the caller information to be linked with a telephone number of the caller terminal, and displaying the stored caller information when a paging signal is received for a call with the caller terminal, wherein the caller information is automatically stored in the receiver terminal by linking a telephone number contained in the data with a telephone number stored in a telephone directory.

nor Applicant’s amended claim 8 limitations of

at a caller terminal, storing caller information and transmitting data including the caller information to a service system during a voice call over a different channel from a channel for the voice call after a call connection is set up; at a receiver terminal, receiving the data from the service system to store the caller information to be linked with a phone number of the caller terminal; and at the receiver terminal, displaying the stored caller information when a paging signal is received for a call with the caller terminal, wherein the caller information is automatically stored in the receiver terminal by linking a telephone number contained in the data with a telephone number stored in a telephone directory.

Since neither Partridge, Hsu, Lee, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant’s claims 1 and 8, as listed above, Applicant’s claims 1 and 8 are not obvious over Partridge in view of Hsu and Lee since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1 and 8, namely claims 2 and 19-20, and 9 and 21-22,

respectively, would also not be obvious over Partridge in view of Hsu and Lee for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-2, 8-9, 19-20 and 21-22 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1, 8, 15, 17 and 19-26 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on March 7, 2007, Applicant respectfully petitions the Commissioner for a one (1) month extension of time, extending the period for response to July 9, 2007 (July 7, 2007 being a Saturday). Applicant submits payment in the amount of \$120.00 to cover the petition filing fee for a 37 C.F.R.

1.17(a)(1) large entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Dated: June 19, 2007

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jean Svoboda

Date: June 19, 2007